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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/813,359	PFLEGER, KARL
	Examiner	Art Unit	
	PATRICK A. DARNO	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*23 May 2008*</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>*1,2,7-9,11-13,38 and 42-60*</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>*1,2,7-9,11-13,38 and 42-60*</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>*31 March 2004*</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>*07032008*</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

DETAILED ACTION

1.   Claims 51-60 are new. Claims 3-6, 10, 14-37, and 39-41 are cancelled. Claims 1-2, 7-9,

11-13, 38, 42-45, 47, and 50-51 are amended. 1-2, 7-9, 11-13, 38, 42-60 are pending in this

office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claims 1-2, 11-13, 38, 42-44, 48-52, and 59 are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Patent Number 6,006,225 issued to Dwayne E. Bowman et al.

(hereinafter "Bowman") in view of Search Engine Showdown, Google News Loses

Functionality, published March 25, 2003 (hereinafter "SES") and further in view of U.S. Patent

Number 6,151,624 issued to Keith Teare et al. (hereinafter "Teare").

Claim 1:

Bowman discloses an automated method, comprising:

receiving a search query *(Bowman: column 3, lines 5-9)*;

determining whether the received search query includes an entity name *(Bowman: column 6,*

lines 5-64);

determining whether to rewrite the received search query based on information relating to

selections of search results from prior searches conducted based on prior search queries

including the entity name corresponding to a particular entity *(Bowman: column 6, line 59 - column 7, line 34)*;

rewriting the received search query when the information relating to selections of search results from the prior searches indicates that users intended the particular entity when the users submitted the prior search queries including the entity name *(Bowman: column 6, line 59 - column 7, line 34)*;

performing a search based on one of the received search query and the rewritten search query to obtain search results *(Bowman: Figure 9)*; and

presenting the search results *(Bowman: Figure 9, element 920 and column 14, lines 13-18)*.

Bowman teaches the step of "performing a search based on one of the received search query and the rewritten search query to obtain search results *(Bowman: Figure 9)*;" by providing hyperlinks to the rewritten search queries, in contrast the claimed invention performs this step automatically. However, MPEP 2144.04 states, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court.

In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

Bowman does not explicitly disclose wherein the rewrite includes a restrict identifier

associated with an entity. However, SES teaches restricting searches to a domain or site of a

news source using a restrict identifier, and Teare discloses resolving an entity name to a

corresponding URL based on statistics from prior queries *(Teare: column 21, lines 39-67)*.

It would have been obvious to one of ordinary skill in the art at the time of the invention

to include the teachings of SES and Teare to allow the user to narrow the search results and to

aid in providing the desired web page. This combination would yield the predictable results

wherein a query is restricted to a domain and the domain is resolved from an entity name based

on prior queries.

Claim 2:

The combination of Bowman, SES, and Teare discloses all the elements of claim 1, as

noted above, and Bowman further discloses providing a link to the received search query, where

selection of the link causes a search to be performed based on the received search query *(Bowman:*

Fig. 9, element 910).

Claim 11

The combination of Bowman, SES, and Teare discloses all the elements of claim 1, as

noted above, and Bowman further discloses where performing a search based on one of the

received search query and the rewritten search query comprises: searching a repository of

documents using the rewritten search query when the received search query is rewritten *(Bowman:*

column 5, lines 11-25 and column 1, lines 44-46).

Claim 12:

Claim 12 is rejected under the same reasons set forth in the rejection of claim 1.

Claim 13:

Claim 13 is rejected under the same reasons set forth in the rejection of claim 1.

Claim 38:

Claim 38 is rejected under the same reasons set forth in the rejection of claim 1.

Claim 42:

Claim 42 is rejected under the same reasons set forth in the rejection of claim 1 and

further in view of Teare: column 7 which teaches searching for a store name and mapping it to

the appropriate domain.

Claim 43:

Claim 43 is rejected under the same reasons set forth in the rejection of claim 1. Also,

note that SES shows that it is desirable to restrict to a domain for a given source name.

Claim 44:

Claim 44 is rejected under the same reasons set forth in the rejection of claim 2.

Claim 48:

Claim 48 is rejected under the same reasons set forth in the rejection of claim 1.

Claim 49:

Claim 49 is rejected under the same reasons set forth in the rejection of claim 1, and

further in view of Bowman: column 4, lines 36-44 which discloses that the search is being

performed to retrieve for documents.

Claim 50:

Claim 50 is rejected under the same reasons set forth in the rejection of claim 43.

Claim 51:

Claim 51 is rejected under the same reasons set forth in the rejection of claim 1 and 43.

Claim 52:

Claim 52 is rejected under the same reasons set forth in the rejection of claims 1, 12, 13,

and 38.

Claim 59:

Claim 59 is rejected under the same reasons set forth in the rejection of claim 2.

3.   Claims 7-9, 45-47, 53-58, and 60 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Bowman in view of SES in view of Teare and further in view of U.S. Patent

Number 6,564,210 issued to Nahum Korda et al. (hereinafter "Korda").

Claims 7 and 45:

The combination of Bowman, SES, and Teare discloses all the elements of claim 1 and

13, as noted above, but the previously mentioned combination fails to explicitly disclose all the

limitations of claims 7 and 45.

However, all the limitations of claims 7 and 45 would have been obvious to one of

ordinary skill in the art at the time the invention was made when the previously mentioned

combination is taken in view Korda. First applicant claims "identifying entity identifiers

associated with documents that were selected in connection with the prior searches involving the

entity name". Korda: column 8, lines 44-59 discloses storing data on documents selected by a

user after a search, this data including the URL of the document which is an entity identifier as

well as the topic which is also an entity identifier, Bowman teaches the search including an entity

name or being an entity name.

Furthermore, Korda discloses:

determining a total number of selections for each of the identified entity identifiers,

(Korda: column 9, lines 14-19 and column 9, lines 20-25), and

and determining that the received search query should be rewritten when an entity

identifier associated with the entity name receives a total number of selections greater than other

ones of the identified entity identifiers *(Korda: column 9 lines 14-25 teaches using the identifiers to narrow*

the search results, and Bowman column 6, lines 32-49 teaches making restrictions based on frequency).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the previously mentioned combination with the teachings of Korda noted

above. Therefore, the limitations of claims 7 and 45 would have been obvious to one of ordinary

skill in the art at the time of the invention as one would have been motivated to provide the

teachings of Korda to increase the productivity of the user *(Korda: column 2, lines 8-14)*.

Claims 8 and 46:

The combination of Bowman, SES, Teare, and Korda discloses all the elements of claims

7 and 45, as noted above, and the limitations of claim 8 would have been obvious in view of

Korda, as Korda further discloses:

determining whether the total number of selections for the entity identifier associated

with the entity name is greater than a threshold *(Korda Col 9 lines 14-19)*, and

determining that the received search query should not be rewritten when the total number

of selections for the entity identifier associated with the entity name is not greater than the

threshold *(Korda: Teaches not further restricting the results until the threshold is met in Col 9 lines 14-19).*

Claims 9 and 47:

The combination of Bowman, SES, and Teare discloses all the elements of claim 1 and

13, as noted above, but the previously mentioned combination fails to explicitly disclose all the

limitations of claims 9 and 47.

However, all the limitations of claims 9 and 47 would have been obvious to one of

ordinary skill in the art at the time the invention was made when the previously mentioned

combination is taken in view Korda. First applicant claims, "identifying entity identifiers

associated with documents that were selected in connection with the prior searches involving the

entity name". Korda: column 8, lines 44-59 discloses storing data on documents selected by a

user after a search, this data including the URL of the document which is an entity identifier as

well as the topic which is also an entity identifier, Bowman teaches the search including an entity

name or being an entity name.

Furthermore, Korda discloses: determining a distribution of a total number of selections

for each of the identified entity identifiers, and determining that the received search query should

be rewritten when the distribution indicates that the total number of selections for an entity

identifier associated with the entity name is peaked compared to the total number of selections

for a subset of other ones of the identified entity identifiers. *(These limitations would have been*

obvious as Korda teaches counting the number of selections as shown above and Bowman teaches making the

selection of further restriction based on frequency and ordered based on frequency in col 6 lines 32-49).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the previously mentioned combination with the teachings of Korda noted

above. Therefore, the limitations of claims 7 and 45 would have been obvious to one of ordinary

skill in the art at the time of the invention as one would have been motivated to provide the

teachings of Korda to increase the productivity of the user *(Korda: column 2, lines 8-14).*

Claims 53 and 55:

Claims 53 and 55 are rejected under the same reasons set forth in the rejection of claims 7

and 45.

Claim 54:

Claim 54 is rejected under the same reasons set forth in the rejection of claims 9 and 47.

Claim 56:

Claim 56 is rejected under the same reasons set forth in the rejection of claims 8 and 46.

Claim 57:

Claim 57 is rejected under the same reasons set forth in the rejection of claims 7, 42, and

45.

Claim 58:

Claim 58 is rejected under the same reasons set forth in the rejection of claims 8 and 42.

Claim 60:

Claim 60 is rejected under the same reasons set forth in the rejection of claims 7, 43, and

45.

Response to Arguments

Applicant Argues:

Without acquiescing in the Examiner's allegation, Applicant submits that <u>Bowman et al.</u> does not disclose or suggest rewriting a received search query to include a restrict identifier relating to a domain associated with a particular entity when information relating to selections of search results from prior searches indicates that users intended the particular entity when the users submitted the prior search queries including the entity name, as recited in claim 1.

Nowhere in this section, or elsewhere, does <u>Bowman et al.</u> disclose or suggest rewriting a received search query when information relating to selections of search results from prior searches indicates that users intend a particular entity when the users submitted the prior search queries including the entity name, as recited in claim 1.

Thus, <u>Bowman et al.</u> does not disclose or suggest rewriting a received search query to include a restrict identifier relating to a domain associated with a particular entity when information relating to selections of search results from prior searches indicates that users intended the particular entity when the users submitted the prior search queries including the entity name, as recited in claim 1.

Examiner Responds:

Examiner is not persuaded. First it is noted that the Bowman reference was not cited alone as disclosing the limitations argued by the Applicant above. The limitations argued above were rejected as being obvious in view of the combination of Bowman, SES, and Teare.

However, it appears to be clear that Bowman discloses rewriting a received search query when information relating to selections of search results from prior searches indicates that users intend a particular entity when the users submitted the prior search queries including the entity name [Bowman: column 6, line 59 – column 7, line 34], as recited in claim 1.

Specifically note that the cited passage of Bowman discloses invoking a "related term selection process." These related terms are discovered based upon queries which were previously ran successfully, which appears to be equivalent to the Applicant's claimed "information relating to selections of search results from prior searches" [Bowman: column 7, lines 4-10 and column 7, lines 14-17]. And finally note that the suggested query terms are presented to

the user in Fig. 9. These terms are suggested to the user because they may be further narrow the

search results presented to a user. By further limiting, or refining, the search results, the user is

better able to find exactly what he/she intended to find.

Since it appears that each and every element of the Applicant's claim language is either

disclosed or suggested by the prior art of record, the claims remain rejected under the reasons

set forth in the preceding office action.

Applicant Argues:

The Examiner alleged that it would have been obvious to include a restrict identifier in Bowman et al. "to allow the user to narrow the search results and to aid in providing the desired web page" (final Office Action, paragraph [0001]). Applicant submits that the Examiner's allegation lacks merit.

Bowman et al. already discloses narrowing search results by presenting related query terms. The Examiner has not explained how the Bowman et al. system would benefit from including a restrict identifier relating to a domain associated with a particular entity.

Examiner Responds:

Examiner is not persuaded. The Examiner is unaware of any requirement under 35

U.S.C. 103(a) which requires showing how a system will benefit from combining features from

multiple references.

However, the courts have clearly decided that "[t]he combination of familiar elements

according to known methods is likely to be obvious when it does no more than yield

predictable results" [*KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S., USPQ2d 1395]. And, as noted

on page 4 of Examiner's final office action mailed 02/25/2008, it appears that the combination of

Bowman, SES, and Teare would provide the predictable results wherein a query is restricted to

a domain and the domain is resolved from an entity name based on prior queries.

Since the results of the combination of Bowman, SES, and Teare are determined to be

predictable, and since no argument was submitted to prove otherwise, the claims remain

rejected under the reasons set forth in the preceding office action.

Applicant Argues:

Bowman et al. appears to disclose searches associated with a single domain (i.e., the Amazon.com web
site) (col. 4, lines 58-67). Thus, even assuming, for the sake of argument that Bowman et al. discloses receiving a
search query that includes an entity name corresponding to a particular entity (a point the Applicant does not
concede), Bowman et al. would not disclose or suggest rewriting the received search query to include a restrict
identifier relating to a domain associated with the particular entity even if one of ordinary skill in the art at the time of
Applicant's invention was aware of Bowman et al. system and the disclosure of SES.

Examiner Responds:

Examiner is not persuaded. The embodiment cited by the Applicant in Bowman:

column 4, lines 58-67 appears to be directed to only a single domain (i.e., the Amazon.com web

site). However, Bowman: column 4, lines 35-40 lists other implementations of the Bowman

invention. An alternative implementation states that the search refinement methods of the

Bowman invention could be implemented as an on-line services network. Surely an "on-line

services network" comprises a plurality of two or more domains.

In such an embodiment, as suggested by Bowman, a search such as that disclosed by the

"source" command disclosed by SES for limiting a search to particular domain would indeed be

useful. Furthermore, the results would be predictable.

Since it appears that each and every element of the Applicant's claimed invention is

either disclosed or suggested by the prior art of record, the claims remain rejected under the

reasons set forth in the preceding office action.

Applicant Argues:

The Examiner also relied upon Teare et al. for allegedly disclosing resolving an entity name to a corresponding URL based on statistics from prior queries (final Office Action, paragraph [0001]). Applicant submits that it is unclear as to what features of claim 1 the Examiner is asserting that Teare et al. discloses. Claim 1 does not recite resolving an entity name to a corresponding URL based on statistics from prior queries.

Examiner Responds:

Examiner is not persuaded. Teare discloses resolving an entity name to a corresponding URL based on statistics from prior queries [Teare: column 21, lines 20-24 and column 21, lines 39-67].

Specifically note Teare: column 21, lines 20-24 which recites, "In block **508**, the Resolver **40 receives a response from index 30 that contains the network address or URL that corresponds to the real name** in the request from the client **70**." (emphasis added by Examiner)

Furthermore, note that the process of resolving the URL from the entity name (real name in the request) includes consulting information from prior queries [Teare: column 21, lines 50-56; Note "statistical information" from "past resolutions" for a particular name.].

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Applicant Argues:

Bowman et al., SES, and Teare et al. also do not disclose or suggest automatically performing a search restricted to the domain associated with the particular entity based on the rewritten search results, as further recited in claim 1.

The Examiner alleged that Bowman et al. discloses performing a search based on a rewritten search query (final Office Action, paragraph [0001]). The Examiner admitted that Bowman et al. does not disclose automatically performing this search, but instead discloses simply providing hyperlinks to rewritten search queries (final Office Action, paragraph [0001]). The Examiner cited to a prior legal decision that allegedly supports the notion that automating a manual activity is not sufficient to distinguish over the prior art (final Office Action, paragraph [0001]). Applicant submits that the Examiner is misapplying the prior legal decision.

Claim 1 does not simply recite automating a manual activity. In other words, performing a search is not a manual activity. It is an automated activity, which is being automatically performed in claim 1. In other words, claim 1 recites that performing a search is automatically performed (e.g., without requiring user intervention). Thus, the prior legal decision does not cure the deficiencies in the Examiner's rejection.

Examiner Responds:

Examiner is not persuaded. As noted in the Examiner's preceding office action, the combination of Bowman, SES, and Teare discloses the limitations of performing a search restricted to the domain associated with the particular entity based on the rewritten search results. And as noted by the Applicant above, it appears that the previously mentioned combination fails to explicitly disclose wherein this step is performed *automatically*.

The Examiner asserts that it is not invention to simply automate a known process of manual steps. The prior legal decision of *In re Venner* [hereinafter "*Venner*"] supports the Examiner's position. The Examiner respectfully disagrees with the Applicant that the ruling set forth in *Venner* was misapplied. In *Venner*, the court held broadly that providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. In light of the holding set forth by the court in *Venner*, the Examiner maintains the position that the Applicant's limitation of performing the search "*automatically*" is obvious over the prior art of record.

Furthermore, it is set forth that recent rulings by the U.S. Supreme Court also appear to support the Examiner's position. In *KSR International Co. v. Teleflex Inc.*, it was set forth that combinations of claim limitations that simply yield predictable results are likely to be obvious [*KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S., USPQ2d 1395]. The Examiner asserts that, to date,

the Applicant has failed to set forth unpredictable results that arise from the automation of the

search performed in the Applicant's claimed invention.   Since it appears that the automation of

the search performed in claim simply yields predictable results, the claims are deemed to be an

obvious variation of the previously mentioned combination of references. However, if the

Applicant could prove that unpredictable results occur from the automation of known manual

steps disclosed by the prior art, the prior art rejections given above <u>may</u> need to be

reconsidered.

Since it appears that the Applicant's claimed invention is simply an obvious variation of

the combination of Bowman, SES, and Teare, the claims remain rejected under the reasons set

forth in the preceding office action.

Applicant Argues:

For example, amended claim 2 recites providing a link to the received search query with the search results, where selection of the link causes a search to be performed based on the received search query. <u>Bowman et al.</u>, <u>SES</u>, and <u>Teare et al.</u>, whether taken alone or in any reasonable combination, do not disclose or suggest this feature.

Examiner Responds:

Examiner is not persuaded. The combination of Bowman, SES, and Teare discloses all

the elements of claim 1, and Bowman further discloses providing a link to the received search

query with the search results, where selection of the link causes a search to be performed based

on the received search query [Bowman: Fig. 9, elements 910 and 920].

Specifically, the links to the received search query are found in Fig. 9, element 910. Also

note that these links are provided in the same page with the search results found in Fig. 9,

element 920. It is important to note that the links to previous search queries in Fig. 9, element

910 point to the received search query, and propose appending an additional search term.

While this link does initiate the modification of the query, it is still clear that it also links to the

originally received search query.

Since it appears that each and every element of the Applicant's claimed invention is

either disclosed or suggested by the prior art of record, the claims remain rejected under the

reasons set forth in the preceding office action.

Applicant Argues:

Claim 50 recites that the entity name corresponds to a store name associated with a particular store, and automatically performing the search restricted to the domain associated with the particular entity includes automatically performing a search restricted to a domain associated with the particular store. Bowman et al., SES, and Teare et al., whether taken alone or in any reasonable combination, do not disclose or suggest these features.

The Examiner did not address these features, but instead simply referred to the rejection of claim 43 (final Office Action, paragraph [0012]). With regard to claim 43, the Examiner alleged that SES shows that it is desirable to restrict to a domain for a given source name (final Office Action, paragraph [0008]). Applicant disagrees with the Examiner's allegation.

SES does not disclose or suggest that it is "desirable" to restrict to a domain for a given source name, as alleged by the Examiner. Instead, SES discloses that it is possible to restrict a search to a particular news source in Google News.

Examiner Responds:

Examiner is not persuaded. First, it is noted for the record that the Examiner did not

"ignore" any claim limitations while constructing the prior art rejections given in the preceding

office action. Each and every limitation of the Applicant's claims have been considered and

granted an appropriate weight.

With respect to the rejections of claims 43 and 50, it is clear that SES discloses restricting

a given search query to a domain for a given source name [specifically, source:

new_york_times]. The Examiner sets forth that this source name can come from any entity that has a URL. It can be a particular web site URL, a news source [as explicitly shown in SES], or a store name found in the URL of an online shopping web site. It follows then that claims 43 and 50 are rejected under similar reasons since the "source name" used with the source operator disclosed by SES could be a new source, or some other entity like the name of a store found in a source title for a store posting an on-line shopping web site [see SES "Instead of site: try using source: which should be followed by either the single word for the source title that Google shows in green..."]. Finally, it is also noted that Teare discloses searching for a store name and mapping it to an appropriate domain [Teare: column 7].

The Applicant also appears to argue that SES fails to disclose or suggest that it would "desirable" to restrict a domain to a specific source name. However, the Examiner is unaware of any requirement under 35 U.S.C. 103(a) which requires showing how a system will benefit from combining features from multiple references. Instead the rulings of the courts, as noted above, appear to be directed to whether or not the results of a combination of references would be predictable. This issue will not be further discussed because it has been elaborated on above.

Since it appears that the Applicant's claimed invention is simply an obvious variation of the combination of Bowman, SES, and Teare, the claims remain rejected under the reasons set forth in the preceding office action.

Applicant Argues:

Claim 51 recites that the entity name corresponds to a name of a particular news source, and automatically performing the search restricted to the domain associated with the particular entity includes automatically performing a search restricted to a domain associated with the particular news source. Bowman et al., SES, and Teare et al., whether taken alone or in any reasonable combination, do not disclose or suggest these features.

The Examiner did not address these features, but instead simply referred to the rejection of claim 44 (final Office Action, paragraph [0013]). With regard to claim 44, the Examiner simply referred to the rejection of claim 2 (final Office Action, paragraph [0009]). Claim 2, however, does not recite any of these features. Thus, the Examiner did not establish a prima facie case of obviousness with regard to claim 51.

Examiner Responds:

Applicant's arguments were found to be persuasive. Claim 51 is now rejected under the same reasons set forth in the claims 1, 42, and 43. The rejection of claim 1 clearly sets forth proper reasons to reject "automatically performing a search restricted to a domain". And the rejections of claims 42 and 43 show that SES discloses wherein the domain the search is restricted to is a news source [source: new_york_times].

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Examiner Notes:

The Examiner notes for the record that a rejection under 35 U.S.C. 101 was considered for claims 52-60. The reason this rejection was considered is because paragraph [0036] of the Applicant's published specification recites that a computer readable medium may comprise a carrier wave.

However, it is noted that the preamble of claim 52 recites more fully "[a] computer-readable <u>memory device</u>." The use of phrase "memory device" appears to be limiting the Applicant to a computer readable medium which can store instructions, therefore creating an apparatus wherein the instructions are functionally and structurally interrelated to the memory device allowing the programmed functionality of the instructions to be realized. Such a medium is disclosed in the Applicant's published specification in portions of paragraph [0036] and [0037].

For the reasons above, a rejection under 35 U.S.C. 101 was not given to claim 52, or any of its subsequent dependent claims. If in the future, it is decided that the "computer-readable memory device" of claim 52 can be interpreted as a carrier wave, a rejection under 35 U.S.C. 101 may be revisited.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICK A. DARNO whose telephone number is (571)272-0788. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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07-31-2008

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